

### **REMARKS**

Claims 1-5 and claims 15-18 are now pending for the Examiner's consideration. Applicants request Examiner's reconsideration of the pending claims in light of the following remarks.

New claim 15 is based on original claim 1 and the new proviso with a modified scope indicated as having support in the written description by the Examiner in the Advisory Action. Hydrogen is deleted from the scope of R<sup>b</sup> in the new claim 15. New claims 16-18 are identical to current claims 2, 3 and 5 except new claims 16-18 depend from new claim 15. No new matter is added.

#### **Rejection under 35 U.S.C. § 112 first Paragraph:**

Claims 1-4 were rejected under 35 USC § 112 first paragraph for lack of written description for the reasons set forth on page 3-4 of the Final Office Action and page 2 of the Advisory Action. Applicants believe the Examiner's application of this provision is in conflict with Ex parte Park (30 USPQ2d 1234, Board Patent Appeals and Interferences, 1993) and In re Johnson (558 F.2d 1008, CCPA, 1977), and respectfully traverse.

In the first place, the Examiner stated in the Advisory Action, that "the Board and the court found in Ex parte Park and in In re Johnson, respectively, that if applicants had exemplified the embodiments excluded by the new provision, then said provision was indeed supported in the written description, even though the proviso was not laid out *ipsis verbis* in the specification".

Applicants respectfully disagree.

In Ex parte Park, the Board found the negative limitation "in the absence of a catalyst" was supported by the original disclosure because there were examples in the disclosure that the claimed method was carried out in the absence of a catalyst, wherein these examples were species falling within the claimed remaining genus, not the genus being excluded out. Further, Applicants note that the Board in Ex parte Park did not require, in order to find support for the claims, that applicants therein exemplified embodiments within the genus excluded by the negative limitation, which would be examples with catalyst, not in the absence of a catalyst.

In In re Johnson, the Court stated, in connection with support for a negative limitation, that 'the only inquiry is whether, after exclusion from the original claims of two species specifically disclosed in the 1963 application, the 1963 disclosure satisfies 112, first paragraph, for the "limited genus" now claimed'. Applicants note that finding of support was directed toward the remaining genus, not the genus being excluded. The Court of In re Johnson then found support for the "limited genus" based on the fact that there were fourteen species and twenty "examples" within the "limited genus". Applicants note that the Court of In re Johnson did not require that the

subgenus which the proviso excluded out from the original genus be supported by exemplified embodiments.

In the second place, The Examiner required that the new proviso be supported by Examples exemplifying every single combination of R<sup>a</sup>, R<sup>b</sup> and R<sup>1</sup> that the new proviso is excluding out from the original genus. The Examiner stated the allowable scope of the new proviso would be "provided when R<sup>a</sup> is H and R<sup>b</sup> is isopropyl, R<sup>1</sup> is not bromide or chloride" based on Example 46 wherein R<sup>a</sup> is H, R<sup>b</sup> is isopropyl and R<sup>1</sup> is bromide, and Example 48 wherein R<sup>a</sup> is H, R<sup>b</sup> is isopropyl and R<sup>1</sup> is chloride. The Examiner also stated that the new proviso "provided that when R<sup>a</sup> is H, R<sup>b</sup> is H or isopropyl, R<sup>1</sup> is not halogen" is not supported by the specification because, there are no examples in the specification where R<sup>1</sup> is iodine or where R<sup>a</sup> and R<sup>b</sup> are both hydrogen.

Applicants note that the Court in In re Johnson allowed a newly added proviso with a scope much broader than that exemplified by the species in the original application. The proviso of In re Johnson stated "with the proviso that E and E' may not both include a divalent sulfone group and may not both include a divalent carbonyl group linking two aromatic nuclei". In re Johnson at 1013. The Court stated in footnote 12 that "the provisos actually exclude more than species [1] and [2]. For Example, polymers similar to species [1] and [2] but having substituted ring structures are also excluded". Id. at 1013. Applicants note that the definition of E encompasses both substituted and unsubstituted dihydric phenol residues. Id. at 1011. Moreover, the original disclosure described more than 50 species of E, many of which had substituted ring structures. Id. at 1012. Applicants note if the Examiner's requirement of supporting the full scope of the new proviso by specific examples as described in the previous paragraph were applicable, in order to find support for the proviso in In re Johnson, it would have required that the original application provides species to exemplify each combination of 1) every possible embodiment of E that includes a divalent sulfone group with 2) every possible embodiment of E' that includes a divalent sulfone group; and each combination of 3) every possible embodiment of E that includes a divalent carbonyl group with 4) every possible embodiment of E' that includes a divalent carbonyl group. Clearly, such requirement was not imposed by the Court of In re Johnson.

Applicants note both the Examiner's interpretation of Ex parte Park and In re Johnson regarding the requirement of written support for negative limitations, and the Examiner's application of this interpretation in rejecting claims 1-4 are in conflict with these two cited cases, as discussed in the previously paragraphs. Applicants respectfully request that the rejection be withdrawn.

**New Claims 15-18**

New claim 15 is based on original claim 1 and the new proviso with a modified scope indicated as having support in the written description by the Examiner in the Advisory Action. Hydrogen is deleted from the scope of R<sup>b</sup> in the new claim 15. New claims 16-18 are identical to current claims 2, 3 and 5 except new claims 16-18 depend from new claim 15. No new matter is added. In light of the previous discussion regarding claims 1-4, Applicants believe new claims 15-18 are in condition for allowance.

**Conclusion:**

In light of the preceding remarks, Applicants request that the Examiner withdraw the rejection of claims 1-4 over 35 U.S.C. §112 first paragraph and acknowledge that the new proviso provided in the July 13, 2006 Amendment are supported by the original specification. Applicants also request that the Examiner rejoin claim 5. Applicants believe that all claims pending are now in condition for allowance and request a Notice of Allowance be issued timely. If the above Amendments and Remarks are not to the satisfaction of the Examiner, Applicants invite the Examiner to contact the undersigned.

If any fees other than those provided herein are due in connection with this response, please charge such fees to Deposit Account No. 500329.

Respectfully submitted,

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